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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Duncan

Serial No.: 09/829,249

Filed: April 9, 2001

For: **ELECTRONIC BOOK WITH MULTIMODE I/O**

Art Unit: 2173

Examiner: Basom

ARC9-2001-0027US1

August 17, 2004
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OFFICIAL

REPLY BRIEF

This responds to new issues raised in the Answer dated August 13, 2004.

The Board should ignore the opening portion of the Answer's argument because it is a straw man, incorrectly alleging that Appellant has couched its argument in terms of "anticipation". Appellant is well aware that the present rejections stand on much flimsier ground, and accordingly has argued against the alleged obviousness of the present claims and has nowhere invoked Section 102 analysis.

Instead, Appellant has analyzed the *actual teachings of the prior art* in evaluating whether a *prior art* suggestion exists to combine the references as proposed in the rejection. That is not "piecemeal" analysis, that is what the law requires, and the conferees would have been better served to observe it.

Unfortunately for the *prima facie* case, the Answer confirms Appellant's point that the references have been combined without the requisite prior art motivation to do so (see, e.g., page 5 line 4 of the Answer, at which the conferees confess a "belief" that the prior art suggests the proffered combination).

The point remains that while one reference teaches two input modes and the other reference teaches two output modes, neither one managed to recognize its reciprocal, and in fact neither one provides any motivation for its reciprocal. This appears to have frustrated the conferees, who attempt to construct

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"suggestions" out of thin air. Consider the allegation on page 5 of the Answer that "the proposed combination *teaches* responding to graphical user input with content comprising graphical content, and responding to audio user input with content comprising audio content". Not only have the conferees (not Appellant) confused Section 102 analysis with Section 103 analysis, in doing so they manifestly have misrepresented the facts, since neither reference "teaches" both multiple input modes and multiple output modes and, thus, at most the references together can only "suggest" the present claims.

Which they do not. Appellant will not repeat the dispositive points it has made in its original Brief but will only observe that mere "similarity" between references, on which the Answer evidently is predicated, see the last line on page 5 and first two lines on page 6, is not a substitute for an actual *prior art* suggestion to combine. Neither are resulting conclusory statements such as the one found on page 7, lines 17-19 to the effect that teachings of Kono are relevant to Oberteuffer simply because they are relevant to the allegedly similar Kono.

The conferees' logic has gone even further awry in respect to the recitation in Claim 13 which includes "maintaining a current position in content and/or a spanning region of the content being rendered such that first and second output threads are run simultaneously with each other." At the bottom of page 9 the Answer attempts to rebut Appellant's point that no evidence exists of record for this recitation by citing the examiner's previous holding that the prior art processor "is considered" an abstract interface and that various claim elements that are absent in the prior art nonetheless have been "understood" by the examiner to be there, charmingly forgetting that an examiner's previous opinions and "understandings" do not form part of the prior art just because they predate the appeal conference.

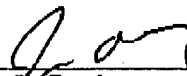
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Respectfully submitted,



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